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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

060258-0290657

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Application Number

10/082,348

Filed

February 26, 2002

First Named Inventor

PASI LAURILA ET AL.

Art Unit

2617

Examiner

IQBAL, Khawar

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

☐ applicant/inventor.

☐ assignee of record of the entire interest.
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)

☒ attorney or agent of record. 41844
Registration number _____

☐ attorney or agent acting under 37 CFR 1.34.

Registration number if acting under 37 CFR 1.34 _____

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November 6, 2006

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.

☐ *Total of _____ forms are submitted.

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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Attorney Docket: 060258-0290657
Client Reference: 2990360US



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re PATENT APPLICATION of: PASI
LAURILA, ET AL.
Application No.: 10/082,348

Confirmation Number: 9575

Group Art Unit: 2617

Filed: February 26, 2002

Examiner: IQBAL, Khawar

Title: UTILIZATION OF SUBSCRIBER DATA IN A TELECOMMUNICATION SYSTEM

ATTACHMENT SHEETS TO PRE-APPEAL BRIEF CONFERENCE REQUEST

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Appellants hereby request that a panel of examiners formally review the legal and factual basis of the rejections in the above-identified application prior to the filing of an appeal brief. Appellants assert that the outstanding rejections (now on appeal by virtue of the concurrently filed Notice of Appeal) are clearly improper based both upon errors in facts and the omission of essential elements required to establish a prima facie rejection (i.e., the prior art references fail to disclose, teach or suggest all the recited claim features).

Appellants are appealing the rejection of claims 1, 13, 25 and 31 under 35 U.S.C. 112, second paragraph for alleged indefiniteness, the rejection of claims 1-11, 14-22, 25 and 27-31 were rejected under 35 U.S.C. 102(e) as being anticipated by Leung et al. (U.S. 6,466,964; hereafter "Leung") and the rejection of claims 12 and 23 under 35 U.S.C. 103(a) as being unpatentable over Leung and Oh (U.S. 6,519,458).

**INDEFINITENESS REJECTION IS IMPROPER AND
PREVIOUSLY SUBMITTED CLARIFYING AMENDMENTS
SHOULD HAVE BEEN ENTERED FOR PURPOSES OF APPEAL**

In response to the Final Rejection wherein the Examiner asserted that claims 1, 13, 25 and 31 were indefinite, Appellants submitted clarifying amendments (omitting the word "subscriber, in "transmitting subscriber data from the terminal..." in the independent method claims with similar amendments to the apparatus claim 31) that further conformed those

claims with the 35 U.S.C. 112 standard and submitted that the claims, when read in light of the specification, clearly indicated that any kind of data which causes a modification of the subscriber database contents can be transmitted from the terminal. In response, the Examiner asserted that the clarifying amendments caused further search and/or consideration, thereby requiring the filing of an RCE for consideration. Moreover, the Advisory Action failed to comment on the arguments for patentability submitted by the Appellants.

Nevertheless, Appellants submit that, even without the clarifying amendments, one of ordinary skill in the art would have understood the scope of the claims.

PRIOR ART REJECTIONS ARE IMPROPER

Appellants assert that both prior art rejections are improper based on errors in facts and omission of essential elements required to establish a prima facie rejection. More specifically, contrary to the assertions of the Final Rejection, the cited prior art fails to disclose, teach or suggest all the features recited in the rejected claims. For example, the cited prior art fails to disclose, teach or suggest the claimed invention wherein there is communication between the terminal and the subscriber database by Internet Protocol (IP) based data transmission, the terminal transmits subscriber data to the subscriber database to modify the subscriber database contents and including automatic transmission, from the subscriber database, of subscriber data relating to the subscriber database.

Leung merely teaches on the subject of Mobile IP and discloses a method for providing IP mobility for a node that does not support Mobile IP. The basic principle of this system is described in Leung at col. 3, lines 4-20, wherein Leung teaches that a foreign agent independently registers a node not supporting Mobile IP with a Home agent. A "virtual" foreign agent is then established in the system to provide the illusion of a single gateway being used for the node.

The Examiner submitted that the claimed creation of a database comprising subscriber data is anticipated by Leung's disclosure of a security association table (see, Leung, beginning of column 8). However, Leung's security association table does not anticipate the claimed subscriber data database, which includes subscriber data and functionally connected to a bearer network providing a terminal with services.

Further, contrary to the assertions of the Examiner, Leung fails to disclose, teach or suggest establishment of a connection between a serving network and the terminal by the subscriber application included in the terminal. The Examiner asserted that col. 7, line 62 –

col. 8, line 16 and Figure 5 allegedly teach this feature; however, this description merely relates to the generation of a registration request by a mobile IP foreign agent and transmission of the registration request to a home agent; thus, Leung merely teaches communication between network elements. Further, Leung fails to teach or suggest utilization of a subscriber application included in a terminal, e.g., a GSM SIM module in an IC card, to establish the connection between the serving network and the terminal.

Moreover, Leung fails to disclose, teach or suggest the claimed arrangement of communication between the terminal and the subscriber database by IP based data. Contrary to the assertions of the Examiner, Leung fails to teach or suggest communication between a terminal and a subscriber database; rather, the AAA server and the security association table are contacted by the foreign agent, i.e., a network element, to establish a registration request (see column 8, lines 4-8 and column 4, lines 39-42).

Further, Leung fails to teach or suggest the claimed automated checking of a right of a terminal to use a subscriber database. The Examiner asserted that Leung's Figure 9 and its associated description define steps performed by the home agent and the foreign agent. It is determined if the registration by the foreign agent is authenticated by the home agent, for instance by using an authentication key shared by the home agent and the foreign agent. Thus, this authentication procedure is not for checking the right of the terminal to use a subscriber database (particularly since the subscriber database was considered to be equivalent with the security association table in an AAA server).

Accordingly, col. 15, line 45 – column 16, line 15 of Leung, and Leung in general, does not anticipate the claimed terminal related feature combination of transmitting subscriber data automatically from the subscriber database to the terminal, providing the terminal with services according to said transmitted data, or transmitting subscriber data from the terminal to the subscriber database to modify the subscriber database contents, as currently claimed in the independent claims.

Further, Oh fails to remedy the deficiencies of Leung because Oh merely teaches generally on the subject of a WAP system. Therefore, the combined teachings of the cited prior art would still have failed to provide the combination of all features recited in the rejected independent claims. Accordingly, claims 1-23, 25 and 27-31 are patentable over the cited prior and allowable and Appellants request issuance of a notice to that effect.

Respectfully submitted,

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